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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,910	06/08/2005	Hyo-Soon Shin	110989-05069441	6702
43569 7590 03/07/2007 MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER CHIN, RANDALL E	
			ART UNIT 1744	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/537,910

Applicant(s)

SHIN, HYU-SOON

Examiner

Randall Chin

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007 and 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:

Claim 1, line 9, the phrase "...inserted into the fixing portion a container cosmetics" is grammatically incorrect.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The added limitation in claim 1, lines 8-9, reciting "and wherein the brush is not distorted when the brush is inserted into the fixing portion" is not originally supported by the original disclosure and therefore constitutes new matter. Note, the specification at p. 1, lines 12-14 and p. 9, lines 3-8 fails to **explicitly and specifically** provide support for this added limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorf 6,779,532 (hereinafter Dorf).

As well as claim 1 is understood, the patent to Dorf discloses a cosmetic applicator (Figs. 1-5), comprising a brush consisting of a plurality of bristles 4, a “fixing portion” at 9 with a hole formed at one end of the fixing portion so that the brush is inserted into the hole, and a ferrule or rod 5 coupled to the fixing portion to support the fixing portion, wherein the fixing portion can be “rectangular-shaped” and is made of plastic material (col. 3, lines 50-51) thereby securing the brush inserted into the hole in a “rectangular shape” (col. 3, lines 38-47).

The added limitation in claim 1, lines 8-9, reciting “and wherein the brush is not distorted when the brush is inserted into the fixing portion” constitutes new matter as already explained above. In any case, such recitation referring to the brush not being distorted when the brush is inserted into the “**fixing portion**” appears to be drawn to a **method step** not germane to patentability in apparatus claims. Whether the brush is or

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is not distorted with respect to a container is deemed patentably irrelevant since a container is not being claimed in combination with the cosmetic applicator.

As for claim 2, the rod is made of plastic, which is deemed to be synthetic resin (col. 3, lines 50-51), and the fixing portion is formed integrally with the rod.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korea 288433.

As well as claim 1 is understood, Korea 288433 discloses a cosmetic applicator (Fig. 2), comprising a brush consisting of a plurality of bristles 20, a "fixing portion" (merely the **distal tip** portion of element 21 in Fig. 2) with a hole formed at one end of the fixing portion so that the brush is inserted into the hole, and a "rod" 21 coupled to the fixing portion to support the fixing portion, wherein the fixing portion is "rectangular-shaped" (a broad phrase), thereby securing the brush inserted into the hole in a "rectangular shape" (again, a broad phrase).

As for the "fixing portion" being made of a plastic material, such a modification (if not already) would be obvious to provide for in order to enable mass production of the device and to make the product lighter in weight.

The added limitation in claim 1, lines 8-9, reciting "and wherein the brush is not distorted when the brush is inserted into the fixing portion" constitutes new matter as already explained above. In any case, such recitation referring to the brush not being distorted when the brush is inserted into the "**fixing portion**" appears to be drawn to a **method step** not germane to patentability in apparatus claims. Whether the brush is or is not distorted with respect to a container is deemed patentably irrelevant since a container is not being claimed in combination with the cosmetic applicator.

As for claim 2, it would have been obvious to make the rod 21 of plastic synthetic resin (if not already) in order to mass produce the device and make it lighter in weight. Also, the fixing portion is formed integrally with the rod.

Conclusion

8. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

To the extent that Applicant's arguments still pertain to the Korea 288433 reference, the added limitations to claim 1 have been deemed adequately addressed in the above rejection. It will be added that the phrase "rectangular-shaped" in claim 1, line 6, is a rather broader phrase than the term "rectangular" by itself. However, Applicant should note that the Examiner is **not** contending that *if* the claim were to recite that the

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fixing portion is actually "rectangular" that this would be allowable. It is simply the Examiner's position that such an amendment referring to the fixing portion being "rectangular-shaped" is insufficient to define over the prior art.

Also, the new matter rejection has been maintained as set forth above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



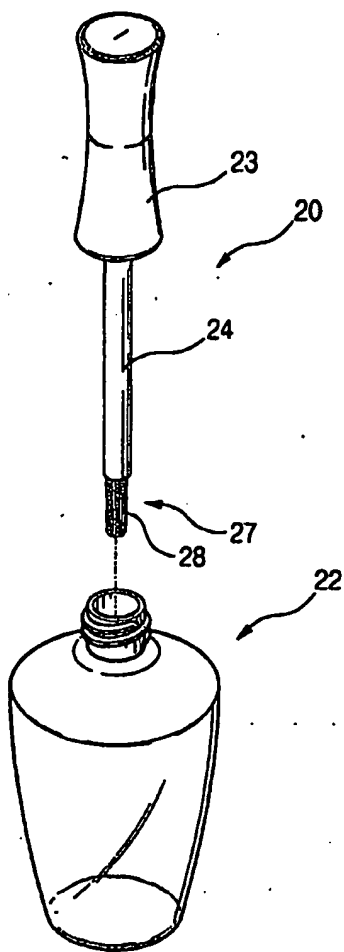
Randall Chin
Primary Examiner
Art Unit 1744



Replacement Sheet

(PRIOR ART)

FIG. 4

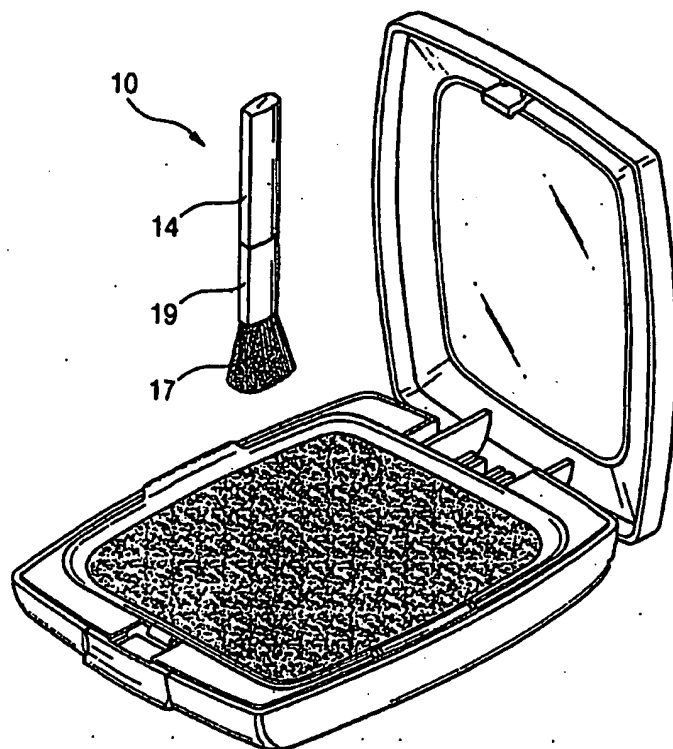


*approved
PC*



(PRIOR ART)

FIG. 5



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